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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,325	01/20/2004	Hsi-Chou Cheng	28142-2	9785

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EXAMINER

FIDEI, DAVID

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/760,325	Applicant(s) CHENG, HSI-CHOU	
	Examiner David T. Fidei	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Construction

1. In analyzing applicant's invention as set out in the pending claims, the examiner sets forth the following to aid in understanding the application of the prior art herein. Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), § MPEP 2106 (II)(c).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan (Patent no. 2,371,557) in view of Zhou (Design Patent no. D446,389). Sullivan disclosed a case a case body 1 including a bottom wall and a surrounding wall extending integrally and upwardly from an outer periphery of said bottom wall to define an eyeglass-receiving space therebetween, said surrounding wall of said case body including an inclined top surface 4. A cover 2 including a top wall and a surrounding wall extending integrally and downwardly from an outer periphery of said top wall, said surrounding wall including an inclined bottom surface 5 that abuts against said inclined top surface of said case body 4, see figure 1. A pivotal portion that is adjacent to said uppermost surface portion of said inclined bottom surface and that is connected pivotally to said

pivotal portion of said case body, and a retaining portion 16, 17 that is adjacent¹ to said lowermost surface portion of said inclined bottom surface and that is locked releaseably on said retaining portion of said surrounding wall of said case body.

The difference between claim 1 and Sullivan is that a clip having a fixed portion is connected fixedly to an outer surface of said surrounding wall of said cover, and a clamping portion extending downwardly from said fixed portion and disposed adjacent to said cover. Zhou teaches that it is well known in the eyeglass case art to attach a clip to an eyeglass cover front wall as shown in figure 1. It would have been obvious to one of ordinary skill in the art to modify Sullivan by constructing a clip having a fixed portion connected fixedly to an outer surface of said surrounding wall of said cover, and a clamping portion extending downwardly from said fixed portion as taught by Zhou, in order to provide a means to carry the case on one's person such as attaching the case to an article of clothing.

As to claim 2, a spring 14 is disclosed that is connected to said case body and said cover so as to bias said retaining portion of said surrounding wall of said cover to turn away from said retaining portion of said surrounding wall of said case body when said retaining portion of said surrounding wall of said cover is released from said retaining portion of said surrounding wall of said case body, see page 2, left side column, lines 20-29.

As to claim 3, the retaining portion of said surrounding wall of said cover is spaced apart from said top wall by a distance which is larger than that between said pivotal portion of said surrounding wall of said cover and said top wall.

4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over The admitted prior art of Figure 1 in view of Rogers (Design Patent no.D436,725) and Hoshino (Patent no. 5,949,515). The admitted prior art of Figure 1 (Fig. 1) in the present specification discloses all of the features of the presently claimed except for a case body meeting the cover in an inclined surface with the cover carrying a clip having a fixed portion connected fixedly to an outer

¹ Adjacent can be interpreted as "near or close to but not necessarily touching", dictionary.com

surface of the surrounding wall of the cover, and a clamping portion extending downwardly from the fixed portion and disposed adjacent to said cover.

Rogers shows that it is well known to those skilled in the eyeglass case art to construct a cover including a top wall and a surrounding wall extending integrally and downwardly from an outer periphery of said top wall, the surrounding wall including an inclined bottom surface (see figures 5 and 8) that abuts against an inclined top surface of the case body. It would have been obvious to one of ordinary skill in the art to modify the case of Fig. 1 by constructing the case body and cover included as taught by Rogers. The motivation for the combination is that Rogers shows this to be an aesthetically enhanced appearance. The design also provides easy access to the eyeglasses by providing a bigger opening in the front of the case opposite the hinged portion.

Hoshino figure 5, also shows it is well known to those skilled in this art to attach a clip 22 to the cover 23 of spectacle case. It would have been obvious to one of ordinary skill in the art to modify Sullivan by constructing a clip having a fixed portion connected fixedly to an outer surface of said surrounding wall of said cover, and a clamping portion extending downwardly from said fixed portion as taught by Hoshino, in order to provide a means to carry the case on ones' person such as attaching the case to an article of clothing.

As to claim 2, in Fig. 1 a torsion spring 14 is disclosed that is connected to said case body and said cover so as to bias said retaining portion of said surrounding wall of said cover to turn away from said retaining portion of said surrounding wall of said case body when said retaining portion of said surrounding wall of said cover is released from said retaining portion of said surrounding wall of said case body, see page 2, left side column, lines 20-29.

As to claim 3, the incline shape taught by Rogers results in a retaining portion of said surrounding wall of said cover is spaced apart from said top wall by a distance which is larger than that between said pivotal portion of said surrounding wall of said cover and said top wall.

REPLY BY APPLICANT OR PATENT OWNER TO THIS OFFICE ACTION

5. “In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to every ground of objection and rejection in this Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. The applicant’s or patent owner’s reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. The reply must be reduced to writing (emphasis added)”, see 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.

Pointing out specific distinctions means clearly indicating in the written response what features/elements or distinctions have been added to the claim/claims, where support is found in the specification for such recitations and how these features are not shown, taught, obvious or inherent in the prior art.

If no amendments are made to claims as applicant or patent owner believes the claims are patentable without further modification, the reply must distinctly and specifically point out the supposed errors in the examiner’s action and must respond to every ground of objection and rejection in the prior Office Action in the same vain as given above, 37 CFR 1.111 (b) & (c), M.P.E.P. 714.02.


The examiner also points out, due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice. “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)” (emphasis mine), see MPEP 706.07(a).

Art Unit: 3728

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fidei whose telephone number is (571) 272-4553. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David T. Fidei
Primary Examiner
Art Unit 3728

dtf
June 27, 2005